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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2615

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,516

Applicant(s)

O'CONNOR ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1,5,8, 11,12,14,16, 18 and 20-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Woo (5,485,219).

Regarding claims 1,5, 8, 11,12,14,16 and 14, Woo discloses a transmitter (Fig. 1) and a receiver, the transmitter comprising: a monitor that monitors an ongoing video transmission and provides an indication when a characteristic is detected; and a transmission device that transmits said video transmission together with said indication, wherein said transmission device is an over the air broadcast television transmitter (Fig. 1,Abstract) or cable television transmitter transmission (column 3, lines 30-35, line 41

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to column 4, line 15) and the receiver comprises a medium for storing instructions that cause a computer to monitor an ongoing video transmission for a predetermined characteristic; and upon detecting said characteristic, automatically record said video transmission by a recorder while said video transmission is being displayed (column 5, line 27 to column 8, line 17).

Regarding claim 18, Woo further including instructions that cause a computer to monitor for a first cue (ON code) to begin the recording of the video transmission and monitor for a second cue (OFF code) to end the recording.

Regarding claims 20 and 21, Woo further teaches instructions that cause a computer to monitor the transmission for a digital signal indicating that recording should begin (column 5, lines 27 to column 8, line 17).

Regarding claim 22, Woo discloses a video receiver comprising: a first device to receive a video signal; a second device coupled to said first device to detect a characteristic of said signal; and a video recorder that records said video signal in response to the detection of said characteristic (columns 10 and 11).

Regarding claim 23, Woo further teaches that the second device detects a cue encoded with the video signal (ON code and OFF code).

Regarding claim 24, Woo teaches that the receiver is a computer system (column 5, lines 25-45, column 6, lines 23-31).

Regarding claim 25, Woo further teaches the receiver automatically concatenates a series of recorded sessions since the receiver can generating instruction to program the recorder to record video programs in accordance with

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schedule information and using ON code and OFF code to start and end recording of sessions.

Regarding claims 26 and 27, Woo further teaches that the second device detects a signal indicating that recording should start and another signal indicating that recording should stop (ON and OFF command codes).

3. Claims 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (5,526,130).

Regarding claim 22, Kim teaches a video receiver comprising: a first device to receive a video signal; a second device coupled to said first device to detect a characteristic of the signal in the vertical blanking interval; and a video recorder that records said video signal in response to the detection of said characteristic (Figs 1,7,8, column 5, lines 55-60) column 6, lines 57 to column 7, line 10, column 8, line 65 to column 9,lines 25)

Regarding claim 23, Kim further teaches the second device detects a cue codes (title, start and end time data) encoded with the video signal.

Regarding claim 24, Kim further teaches the receiver is a computer system (60).

Regarding claim 25, Kim further teaches the receiver automatically concatenates a series of recorded sessions (a plurality of programs recorded on the medium).

Regarding claim 26, Kim further teaches the second device detects a signal indicating that recording should start and another signal indicating that recording should stop (start time and end time data).

Regarding claim 27, Kim further teaches the said first device receives the d video

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signal from a broadcast source, said signal including a cue to indicate the start of recording by said video recorder (start time).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-4, 9-10, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo in view of Yoneda (6,233,390)

Regarding claims 2, 9 and 17, Wood fails to specifically teach monitoring an ongoing video transmission includes monitoring for the transition from a live broadcast to a replay. However, it is noted that it is obvious to one of ordinary skill in the art that a user or an operator can monitor the transition from a live video transmission to a

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replay by watching the video transmission on a monitor.

Regarding claim 3, Woo further teaches that monitoring an ongoing video transmission includes monitoring for a first cue to begin the recording of the video transmission and monitoring for a second cue to end the recording by using the start time and end time of the recording (Off command and ON command codes associated with a channel to be recorded).

Regarding claims 4 and 19, Woo fails to specifically teaches including displaying on a display screen the video transmission together with one or more representations of portions of the video transmission which have been recorded .

However, it is noted that using a control means for controlling the display of the video transmission and recorded portion of a video transmission on the same screen is well known in the art as taught by Yoneda (column 10, lines 15-45). Therefore, it would have been obvious to one of ordinary skill in the art to modify Woo with Yoneda by using a control means as taught by Yoneda for controlling and displaying the video transmission and recorded portion of a video transmission on a screen, thereby enhancing the capacity and functions of the apparatus.

Regarding claim 10, Woo as modified with Yoneda further teaches including enabling the recorded video transmission to be replayed, and then accelerating the rate of replaying a portion of the transmission that occurred when the recorded video transmission was being played (column 5, lines 40-47).

6. Claims 6, 7, 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over Woo in view of Kim

Regarding claims 6,7 and 15. Woo fails to teaches monitoring the video transmission including monitoring a vertical blanking interval. However, it is noted that monitoring a vertical blanking interval for control signals therein is well known in the art as taught by Kim. Therefore, it would have been obvious to one of ordinary skill in the art to modify Woo with the teaching of Kim by providing ON code and OFF code in the vertical blanking interval of the video transmission and means for monitoring the indication of ON and OFF code in the vertical blanking interval thereby preventing interference between characteristic and video data of the video transmission.

Regarding claim 13, Woo fails to teach that the transmitter is a satellite transmitter. However, it is noted that using a satellite transmitter fro transmitting video transmission is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to use a satellite transmitter for transmitting the video transmission.

7. Claims 1-3 and 5-9, 16-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Isaka (5,706388).

Regarding claim 1, 3, 5-8 and 16-17 and 20-21, Kim discloses a transmitter comprising: a monitor that monitors an ongoing video transmission and provides an indication when a characteristic is detected; and a transmission device that transmits said video transmission together with the indication, wherein said transmission device is a over the air broadcast television transmitter and the indications include title, start time end time codes are inserted in a vertical blanking interval of the video transmission .

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Kim further teaches a receiver for monitoring the characteristic of indications of the ongoing broadcast channel (video transmission), detecting the indication and automatically recording the video transmission in accordance with the detected indication (title, start and end time, (Figs 1,7,8, column 5, lines 55-60, column 6, lines 57 to column 7, line 10, column 8, line 65 to column 9, lines 25).

Further for claims 16 and 18, 20-21, Kim further teaches an article comprising a medium for storing instructions that cause a computer (60) monitors an ongoing video transmission for a predetermined characteristic (title, start and end codes); and upon detecting said characteristic, automatically record said video transmission (Figs. 7-8).

Kim fails to specifically teach that recording of the video transmission while the video transmission being displayed.

However, it is noted that using a control means for enabling a recorder to record video transmission when the video transmission being displayed is well known in the art as taught by Isaka (Fig. 1 column 1, lines 60-65). Therefore, it would have been obvious to one of ordinary skill in the art to modify Kim with Isaki by using a control means as taught by Isaka with the apparatus of Kim to enable of the recording of the video transmission when the video transmission being displayed thereby enhancing the capacity of Kim apparatus.

Regarding claims 2 and 9, Kim as modified with Isaka further teaches monitoring the replay of the video transmission since the user can watch the displayed video transmission and monitoring a replay of the video transmission.

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lynch et al and Logan et al teach time shifting video signal play back. Hashimoto et al teach an apparatus for recording a video signal when a characteristic of a video signal is detected.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER ccccustomer service whose telephone number is (703) 306-0377.

H.N
September 8, 2002


HUY T NGUYEN
PRIMARY EXAMINER